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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,912	09/17/2003	Stephany Jean Head	4803.001	2623
7590 05/12/2009				
William C. Schrot Liniak, Berenato & White, LLC Suite 240 6550 Rock Spring Drive Bethesda, MD 20817				
EXAMINER				
POND, ROBERT M				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
05/12/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/663,912

**Applicant(s)**

HEAD, STEPHANY JEAN

**Examiner**

Robert M. Pond

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

All pending claims 1-6, 8 and 10-14 were examined in this non-final office action necessitated by new grounds of rejection. The Applicant is reminded that twice rejected claims are eligible for appeal.

### ***Response to Arguments***

Applicant's arguments filed 23 January 2009 have been fully considered but they are not persuasive.

*Applicant- The Disclosure is Enabling:* The Examiner respectfully disagrees with the Applicant's position. Undue experimentation is necessary to ascertain an outcome (i.e. win probability is increased). Given the wide field of subjective input required from a user, citing an example is not sufficient in the Examiner's opinion to demonstrate that the subjective information supplied via mental steps of the user is predictable and repeatable. For instance, suppose two companies competing for the same complex contract use the claimed invention to increase their win probability, each supplying subjective information via mental steps. For the situation where only one of the two bidders can win, did the losing company actually increase its win probability? Multiple bidding experimentation using the claimed invention over time is necessary to determine increase in win probability.

Applicant- The Claims are Definite: For the reasons noted above, one cannot assure a predictable and repeatable outcome.

Claims 1-6, 8 and 10-12 are directed to Statutory Matter: The Examiner respectfully disagrees with the Applicant's position. The grounds of rejection remain regarding non-statutory subject matter and has been clarified. The claimed invention fails to pass the machine-or-transformation test. In light of *In re Bilski*, method claims must meet a specialized, limited meaning to qualify as a patent-eligible process claim. The present method claims are unpatentable as directed to nonstatutory subject matter under 35 U.S.C. §101 since Applicant's claimed invention i) relies on a mere field of use of computing technology as disclosed by the specification and ii) relies on insignificant extra-solution activity such as data gathering or outputting by a machine. Please note that insignificant extra solution activity will not transform an unpatentable principle into a patentable process. Correction is required.

Claims 13 and 14 were added to this rejection. While each claim implies a tangible embodiment of the instructions executed by a computer, insignificant extra-solution activity such as data gathering or outputting by a machine is claimed as disclosed by the instant specification. Rejections are based on case law and rationale as noted above for claims 1-6, 8 and 10-12.

Regarding claim 15. While prosecution history indicates claim 15 objected (#20070815), case law on the other hand moves forward. In particular *In re Bilski*

clarified the standards applicable in determining whether a claimed method constitutes a statutory process under 35 USC 101.

***Claim Rejections - 35 USC § 112, First Paragraph***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**1. Claims 1-6, 8 and 10-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The background of the invention sets forth the state of the art and the predictability of the art is lacking (page 3 of specification lines 1-6 - in many decisions involving complex contracts, it is relatively difficult to define the buying-organization's business logic....) therefore, requiring the applicant to give sufficient guidance and direction. The instant specification, however, is filled with generalities and examples but lacks specifics. The Applicant's instant specification lacks specifics and sufficient guidance and direction to support a predictable, repeatable and concrete result. Given the lack of sufficient guidance and direction provided by the instant specification, it is determined the claimed invention does not provide a predictable, repeatable and concrete result thereby requiring undue experimentation. Please refer to MPEP at least 2164.01(a).

***Claim Rejections - 35 USC § 112, Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claims 1-6, 8 and 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Specific to the Applicant's claims at least but not limited to "identifying an industry standard," "assigning numerical values," "adjusting each of the assigned numerical values" and "framing a response" are actions required by a user of the claimed invention, the user being a human and therefore subject to unpredictable input based on individual interpretation of the data for purposes of assigning, adjusting, establishing a pre-determined range and framing a response.

***Claim Rejections - 35 USC § 101***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

- 2. Claims 1-6, 8 and 10-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Based on Supreme Court precedent and recent Federal Circuit decisions, a process that consists of a series of steps or acts to be performed must i) be tied to another statutory class (such as a particular apparatus) or ii) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 USC 101. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876); *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008).

The claimed invention fails to pass the machine-or-transformation test. In light of *In re Bilski*, method claims must meet a specialized, limited meaning to qualify as a patent-eligible process claim. The present method claims are unpatentable as directed to nonstatutory subject matter under 35 U.S.C. §101 since Applicant's claimed invention i) relies on a mere field of use of computing technology as disclosed by the specification and ii) relies on insignificant extra-solution activity such as data gathering or outputting by a machine. Please note that insignificant extra solution activity will not transform an unpatentable principle into a patentable process. Correction is required.

Claims 13 and 14 were added to this rejection. While each claim implies a tangible embodiment of the instructions executed by a computer, insignificant extra-solution activity such as data gathering or outputting by a machine is

claimed. Rejections are based on the case law and rationale as noted above for claims 1-6, 8 and 10-12.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service



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Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert M. Pond/  
Primary Examiner, Art Unit 3625  
May 8, 2009